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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,118	02/03/2006	Norbert Holl	2732-167	8956
6449 7590 02/18/2009 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
BITAR, NANCY				
ART UNIT		PAPER NUMBER		
2624				
NOTIFICATION DATE		DELIVERY MODE		
02/18/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

# Office Action Summary

**Application No.**

10/528,118

**Applicant(s)**

HOLL, NORBERT

**Examiner**

NANCY BITAR

**Art Unit**

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments see pages 8-10, filed 02/02/2009, with respect to the rejection(s) of claim(s) 1-23 under 102 (b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ishida et al (US 4,352,988).

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-12 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process

NOTE: Regarding the rejection of claims 1-8, please see the Memorandum dated May 15, 2008, "Clarification of Processes under 35 USC § 101" which may be viewed at the following web address:

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section101\\_05\\_15\\_2008.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section101_05_15_2008.pdf)

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laskowski et al (US 6,101,266) in view of Ishida et al (US 4,352,988).

As to claim 1, Laskowski et al teaches in figure 1 a method for checking a document of value, with which the document of value, at least in a partial area is illuminated with an intensity, (each spot sensing assembly includes four emitters 32 each of the emitters produces radiation at different wavelengths, figure 1) and at one or more measuring places (2) (entry end 14 to an exit end 16, figure 1, column 5, lines 54-66) the intensity of the light transmitted through the partial area of the document of value and the intensity of the light reflected (a control circuit 24 produces sensed

values that correspond to the detected radiation), in particular remitted, by the partial area of the document of value is captured, characterized in that the intensities of the transmitted and reflected light are captured separately ( the reflectance detector 20 is in operative connection with, and outputs first signals and a second signal, column 6, lines 1-12 and abstract), for the measuring place or the individual measuring places the respective sums of the intensities of the transmitted and reflected light are calculated ( the control circuit calculates a level of correlation between the stored values and the sensed values , column 5, lines 54-column 6, lines 1-12, see figure 4) the sum intensity value for each measuring place is each compared to a predetermined standard value ( by comparing the correlated values to threshold values , the control circuit is operative to determine the type of note and other conditions such as if a note is worn, soiled, or a double note). While Laskowski et al meets a number of the limitations of the claimed invention, as pointed out more fully above, Laskowski et al fails to specifically teach the sum intensity value of each measuring place is each compared to a predetermined standard value. Specifically, Ishida et al. teaches the a first detecting system for detecting light transmitted through a sheet and a second detecting system for detecting light reflected by the front surface of the sheet, a third detecting system for detecting light reflected by the rear surface of the sheet. The light doses sensed by these detecting systems are integrated by respective integrators for a predetermined period of time, and the outputs obtained from the integrators are coupled to an adder and added together therein. The sum output of the adder and a reference signal generator are compared with each other in a comparator, and the determination as to whether the

sheet in question is adequate for re-use or not is effected on the basis of the result of the comparison ( abstract, figure 1 and 5) it would have been obvious to one of ordinary skill in the art to compare each sum intensity with a predetermined value using individually the adder 102,104 and comparators 106 and 198 in Laskowski in order to observe the presence of soiling from any deviation. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention by applicant.

As to claim 2, Laskowski et al teaches a method according to claim 1, characterized in that the intensity values captured from the measuring place or the individual measuring places are corrected before the summation for compensating locally differing measuring conditions ( column 17, lines 17-32).

As to claim 3, Laskowski et al teaches a method according to claim 2, characterized in that the correction is effected for compensating local intensity fluctuations in illumination given when measuring ( column 17, lines 17-32).

As to claim 4, Laskowski et al teaches a method according to claim 2, characterized in that the correction is effected for compensating locally differing detector specifications (figure 2, 22).

As to claim 5, Laskowski et al teaches a method according to claim 4, characterized in that each captured intensity value before the summation is reduced by a dark current measuring value determined for the respective measuring place ( note that correlation values calculated may be tailored to note properties and area of interest, column 10m lines 1-3).

As to claim 6, Laskowski et al teaches a method according to claim 5, characterized in that for determining the dark current measuring values intensity measuring are effected with switched-off illumination (all the blue emitters go off and all the green emitters in each of the spot sensing assemblies come on, column 7, lines 6-21).

As to claim 7, Laskowski et al teaches a method according to claim 1, characterized in that each captured intensity value, is multiplied with a correction factor determined for the measuring place of the respective intensity value (These overall values are then multiplied together to calculate a final value indicative of correlation of the stored value set and the test note, column 9, lines 41-48; see Ishida abstract).

As to claim 8, Laskowski et al teaches a method according to claim 7, characterized in that the correction factors are obtained on the basis of the intensity values, which are determined by means of intensity measuring in reference documents ( column 23, lines 53 to column 24, lines 1-9; see also Ishida reference signal generator; see also Ishida figure 1).

As to claim 9, Laskowski et al teaches a method according to claim 1, characterized in that the document of value in a transportation direction is guided past an illumination system and a detector system positioned to this, and with the illumination system at least on one side of the document of value an illumination profile is produced, which extends transverse to the transportation direction (see figure 2-3, note that FIG. 14 is a graphical representation of reflectance signals obtained from transversely disposed spot sensing assemblies for a skewed note, which signals are used by the control circuit to determine an angle of skew; see also Ishida abstract and figures 5-6).

As to claim 10, Laskowski et al teaches a method according to claim 9, characterized in that with a plurality of detector elements, which are positioned in a row at right angles to the transportation direction( see figure 9) , the intensity values along a plurality of measuring tracks extending in parallel to the transportation direction are captured ( note that the control circuit 24 has the advantage that each of the digital signal processors operates in parallel on the master templates stored in its associated memory).

The limitation of claims 11-13 has been addressed above see Laskowski figure 2 and 3 and Ishida (abstract).

Claims 13-22 differ from claim 1-12 only in that claims 1-12 are method claims whereas, claims system claims. Thus, claims 13-22 are analyzed as previously discussed with respect to claims 1-12 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY BITAR whose telephone number is (571)270-1041. The examiner can normally be reached on Mon-Fri (7:30a.m. to 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jing Wu can be reached on 571-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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